United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 15270

PREFORMED LINE PRODUCTS COMPANY, APPELLANT

v.

ROBERT C. WATSON, Commissioner of Patents, APPELLEE

Appeal from the United States District Court
for the District of Columbia

Decided June 9, 1960

Mr. Patrick H. Hume, with whom *Messrs. C. Willard Hayes and George M. Sirilla* were on the brief, for appellant.

Mr. *George C. Roeming*, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before PRETTYMAN, *Chief Judge*, and BAZELON and FAHY, *Circuit Judges*.

FAHY, *Circuit Judge*: This is an appeal from an order of the District Court denying appellant's motion for a new trial after our demand of the case on a previous appeal. *Preformed Line Prods. Co.* v. *Watson*, 103 U.S. App. D.C. 286, 257 F.2d 664, *cert. denied*, 358 U.S. 945. We then vacated conditionally the judgment of the District Court of March 13, 1957, dismissing appellant's complaint

under 35 U.S.C. §145 (1958), which had sought issuance of a patent.

In the former case, the District Court had rejected appellant's claims on two alternative grounds: first, it agreed with the Patent Office in holding that certain of appellant's claims were barred because of res judicata growing out of various proceedings in the Patent Office,[1] and that the other claims were barred because of lack of novelty; second, it held that all the claims before the court on the merits lacked the requisite novelty over the teaching of the prior art. Since, however, the second or alternative holding of nonpatentability was not framed as an issue before the court at the outset of the proceeding, on demand of the case we ordered that the District Court's judgment be conditionally vacated "in the interest of justice," with permission given to appellant to apply within sixty days for a new trial "based on a proffer of evidence on the issue of patentability." After unsuccessful petitions for rehearing in this court and certiorari in the Supreme Court appellant moved within the proper time for a new trial in the District Court and that motion was denied.

Involved are applications[2] for a patent entitled "Helically-Preformed Wire Envelope and Methods of Use." The applications disclose preformed helical (spiral) elements and certain kinds of tube-like metal structures which are produced from these helical elements. In various combinations and lengths depending on their purpose

[1] Specifically the holding was that in the absence of a perfected appeal to the Court of Customs and Patent Appeals, the nonvacated decision of the Board of Interference Examiners adverse to appellant was a final judgment as to claims involved in the interference proceedings and therefore res judicata.

[2] Two applications are involved. Serial No. 698,312 and Serial No. 2,260. The latter is a continuation-in-part of the former.

these preformed helices are used for the reinforcement, splicing, armoring and dead-ending of electrical transmission lines and other wires and cables.

The prior art upon which the District Court primarily relied in rejecting all of appellant's claims on the merits was a patent issued to one Moxham in 1886. That patent discloses the same basic helically preformed element as found in appellant's applications and a plurality of these preformed elements indefinite in length which could be useful as a traction cable for cable railways. In another form of the Moxham patent helically preformed elements of the same diameter and pitch could be assembled to form a hollow flexible tube.

Upon re-examination of the issue of the propriety of the District Court's action in raising and deciding the issue of patentability *vel non*, we conclude as we did in the prior appeal that such action was authorized in law. *Preformed Line Prods. Co.* v. *Watson*, 103 U.S. App. D.C. at 288, 257 F.2d at 666 (footnote 2 and cases therein cited).

We think, moreover, that the findings of the District Court on the issue of patentability, both as to those claims in which it agreed with the Patent Office and also those where it ruled *sua sponte*, were justified. Differences appellant claims between the disclosures of the two patents are differences only of degree and use which would be obvious from Moxham to one having ordinary skill in the art. For instance, the claims upon which the District Court made *sua sponte* findings of unpatentability over Moxham were so-called "method claims." But these methods, mainly concerning the assembling of the preformed helical elements either to form a hollow tube or a tube over a core, suggest no significant advance

from what would be obvious to one skilled in the art upon the disclosure of Moxham.

Finally, the proffer of evidence submitted by appellant in his motion for new trial and affidavit in support thereof, did not in the circumstances require the court to grant a new trial. Aside from his proffer of the prosecutional history of the Bodendieck patent[1] in the Patent Office, appellant offered only "expert testimony," unspecified as to source or content, to support his claim of patentability over Moxham. The possible relevance of the Bodendieck history was not shown and the proffer of expert testimony was in terms too general to require the grant of a new trial.

Since we find no error in the holding of the District Court on the issue of patentability over the prior art, and since all of appellant's claims on the merits were rejected by the District Court on the basis of the prior art, we need not rule on other questions raised.

The order of the District Court denying appellant's motion for a new trial is affirmed, and the judgment entered by the District Court in this cause on March 13, 1957, is reinstated.

It is so ordered.

[1] With reference to certain of appellant's claims an interference was declared in the Patent Office between appellant's applications and that of one Bodendieck.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The following are the Findings of Fact and Conclusions of Law adopted by the trial Court (Order, Joint App. 25, 26) as set forth in the Joint Appendix at pages 26 to 35, and 38 to 40, all inclusive, except that plaintiff's proposed Conclusions of Law, P-1, P-5, P-7, P-10, and P-11, allowed by the Court, have been renumbered in the Conclusions of Law set forth below as Nos. 14 to 18 inclusive, so as to follow consecutively Conclusions of Law 1 to 13, inclusive, as submitted by the defendant and adopted by the Court.

Note that in denying defendant's motion (Joint App. 41) to amend Conclusions of Law by striking plaintiff's Conclusion of Law P-5. (Conclusion of Law 15 below), the Court entered the following order (Joint App. 43):

> "ORDERED that paragraph (1) of the defendant's Motion to Amend Conclusions of Law be and the same is hereby denied, it being the ruling of the Court that the Commissioner of Patents has original jurisdiction of interference proceedings such as Interference No. 83,266; that the United States District Court for the District of Columbia and the United States Court of Customs and Patent Appeals have alternate statutory review; and that the United States Court of Appeals for the District of Columbia Circuit and the United States Supreme Court have appellate jurisdiction; * * *."

FINDINGS OF FACT

1. This is an action brought under Title 35 of the United States Code, Section 145, in which plaintiff, Preformed Line Products Company, sought to have the Court authorize the allowance of claims 3, 6, 7, 10, 11, 15 through 20, 22, 24, 26, 27, 30, and 31 of Peterson patent application Serial No. 698,342 claims 4, 5, 8, 9, 14, 21, and 25 having

been allowed by the examiner and claims 12 13, and 23 having been held patentable by the Board of Appeals. Claims 6, 7, 10, 11, and 22 were eliminated from the case by the granting prior to trial of plaintiff's motion to dismiss as to those claims.

2. In this action plaintiff further sought to have the Court authorize the allowance of claims 1 through 11, 13 through 16, and 21 through 28 of Peterson patent application Serial No. 2,200, which claims are all the rejected or nonallowed claims remaining therein.

3. The application in suit discloses preformed helical elements and various species of tube-like structures produced from such preformed helical elements for use as envelopes for elongated bodies, cable splices, vibration dampeners, etc. Each application discloses also at least one specific method of assembling preformed helical elements as an envelope on a core.

4. Claims 16, 17, 18, 20, and 24 of application Serial No. 698,312 and Schedule A of the complaint are not readable on the species elected for prosecution in that application in the absence of an allowable generic claim and, therefore, are not before the court for judgment on the merits. Claims 3, 15, 19, 26, 27, 30, and 31 set forth in the same application and schedule are before the Court on the merits.

5. Claims 1 through 5, 7, 9 through 11, 13, 14, 15, 21, and 22 of application Serial No. 2,200 and Schedule B of the complaint are not readable on the species elected for prosecution in that application in the absence of an allowable generic claim and, therefore, are not before the Court for judgment on the merits. Claims 6, 8, 16, and 23 through 28 set forth in the same application and schedule are before the Court on the merits.

6. Claims 26, 27, and 31 of the earlier Peterson application are identical with claims 27, 28 and 16, respectively, of the later Peterson application.

7. The following findings 9 through 21 are pertinent to the issue of *res judicata* involved in claims 26, 27, and 31 of the earlier Peterson application and claims 27 and 28 of the later Peterson application.

8. All the facts of following findings 9 through 16, 19, 20, and 21 are pleaded in plaintiff's complaint and are admitted in defendant's answer.

9. After claims of the earlier Peterson application were rejected on Bodendieck patent No. 2,414,136, issued January 14, 1947, Peterson copied claims from said patent in that application for purposes of interference with said patent. After final rejection of the copied claims on the ground that the disclosure of the earlier application does not support them, an appeal was taken to the Board of Appeals (Appeal No. 15,663).

10. During the pendency of that appeal, Peterson filed the later of the applications involved in this action and designated it a continuation-in-part of the earlier application. The later application included original claims copied from the Bodendieck patent No. 2,414,136 which claims were identical with similarly copied claims in the earlier application.

11. Interference No. 83,256, Peterson v. Bodendieck, was subsequently declared between Peterson's later application and the said Bodendieck patent on the claims copied therefrom.

12. Subsequently, the Board of Appeals in above-mentioned Appeal No. 15,663 reversed the examiner to the

extent of holding that Peterson's earlier application would support certain claims copied from the Bodendieck patent.

13. Thereafter, Peterson moved to add his earlier application to Interference No. 83,266 in support of the issues thereof.

14. The examiner then dissolved the interference on the ground that the counts were not supported by either of Peterson's applications; but he was subsequently persuaded to permit the interference to proceed to final hearing for determination of the question of support for the claims.

15. In its decision on final hearing, the Board of Interference Examiners adopted the reasoning of the examiner in his decision dissolving the interference and held that Peterson could not make the claims derived from the Bodendieck patent in either of his applications. Priority of invention was awarded to Bodendieck.

16. Timely notice of appeal to the Court of Customs and Patent Appeals, in accordance with 35 U.S.C. 59a, R.S. 4911, then in effect, was given by applicant to the Commissioner of Patents from the above-mentioned decision of the Board of Interference Examiners, and no election was made by Bodendieck to have further proceedings conducted under 35 U.S.C. 63, R.S. 4915, then in effect.

17. Thereafter, but prior to expiration of the time available for perfecting the appeal to the Court of Customs and Patent Appeals, Bodendieck filed a statutory disclaimer (under 35 U.S.C. 65, R.S. 4917, then in effect) of his patent claims at issue in the interference proceedings and also Bodendieck's concession of priority of invention in the subject matter of the interference counts to Peterson.

18. Thereafter, in the Patent Office applicant seasonably moved to vacate the judgment of the Board of Interference Examiners in above-mentioned Interference No. 83,266, and further moved to dismiss the *inter partes* appeal to the Court of Customs and Patent Appeals; but his motions were denied by the Assistant Commissioner of Patents.

19. Subsequently, after Bodendieck filed a paper noting that Peterson had not perfected his appeal to the Court of Customs and Patent Appeals within the time allowed, the Assistant Commissioner ruled that, under Rule XXV of said Court, the interference proceedings were terminated and the Peterson applications were to be remanded to the primary examiner for further prosecution.

20. The examiner thereafter finally rejected the claims derived from the Bodendieck patent, as well as other claims held not to distinguish materially therefrom, in both the earlier and later Peterson applications on the basis of the decision of the Board of Interference Examiners at final hearing in Interference No. 83,266, holding that Peterson's applications do not support those claims.

21. On appeals from the final rejections, the Board of Appeals (Appeals No. 343-33 and No. 343-34) held that the rejection of the claims mentioned in finding of fact 20 and including all the claims mentioned in finding of fact 7 was essentially on the ground of *res judicata* and affirmed the examiner.

22. On the same appeals, the Board of Appeals did *not* hold that the doctrine of *res judicata* was applicable to the same claims on the basis of the decision of the Board of Appeals in Appeal No. 15,663, mentioned above in findings of fact 9 and 12.

24. The Moxham patent No. 337,513 of March 9, 1886,

discloses a wire cable formed of a plurality of preformed helical wires which are identical in shape with Peterson's preformed wires but of no definite length. The cable may be made with or without an internal core. If a core is used, the internal diameter of the preformed helical wire may be equal to or slightly less than that of the core. The resulting structure is elastic and compact. When the core is omitted, there is produced a tube of indefinite length composed of helices which are mutually coherent.

24. Claims 3, 15, 19, and 30 of the earlier application include neither an express nor implied limitation as to length. These claims distinguish from Moxham only in matters of degree expressed in terms of intended purpose, function, desired characteristic, or capability. These claims fail to distinguish structurally in matters of kind from Moxham. These claims do not define invention over Moxham.

25. Claims 6 and 8 of application Serial No. 2,200 which recite "a vibration dampener for suspended lines" distinguish from a length of the Moxham cable only in terms of intended use. The substance of the clause "adapted for connection with the line" is inherent in almost any free body and particularly in that of Moxham. The core of Moxham is a "filler substance" and occupies the central portion as well as other portions of the envelope tube. These claims define no invention over Moxham.

26. The publication entitled "P.F.T. Preformed Armor Rods and Multiple Wire Ties" bears a copyright date of 1946 and discloses a pair of wrenches and their use in applying preformed helical armor wires to energized power lines without interrupting service. Half of the rods are placed in the upper oblong slot and the other half into the lower slot of each tool. In position with respect to the

line, the jaws are closed and while one wrench is held stationary the other wrench is rotated and moved outwardly to effect the wrapping for one half the longitudinal extent of the armor. This latter wrench is then clenched over the armor and held stationary while the formerly stationary wrench is rotated around the line and moved outwardly toward the other end to complete the wrapping.

27. Claim 16 of application Serial No. 2,200 was held by the Board of Appeals to be adequately supported by the disclosure of that application. This claim is identical with claim 31 of application Serial No. 698,312; but since the decision of the Board of Interference Examiners, holding said claim 31 not supported by the disclosure of application Serial No. 698,312, is in this action found to establish *res judicata* as to that issue, claim 16 is supported only by the disclosure of application Serial No. 2,200, filed January 14, 1948, and is fully anticipated by the disclosure of the 1946 "P.F.T." publication which constitutes a statutory bar.

28. Claims 27 and 28 of application Serial No. 2,200 are identical with claims 26 and 27 of application Serial No. 698,312. Since the decision of the Board of Interference Examiners holding said claims 27 and 28 not supported by the earlier application is in this action found to establish *res judicata* on that issue, those claims have no effective filing date prior to January 14, 1948. Claim 27 is fully anticipated by the disclosure of the "P.F.T." publication of date 1946 which constitutes a statutory bar. Claim 28 differs from the "P.F.T." publication disclosure only in the limitation "outwardly toward both ends . . . . simultaneously." The substance of that limitation is such that the subject matter of this claim would have been obvious at the time the alleged invention was made to a person hav-

ing ordinary skill in the art. Claim 28 sets forth no invention over the "P.F.T." publication.

29. Claims 23 through 26 of application Serial No. 2,200, drawn to method, are inadequately supported by the application disclosure. Claims 23 and 24 are not supported by disclosure of either "simultaneously twisting the groups" or "mutually twisting said helical units." Claims 23 through 26 are not supported by disclosure of how the groups of elements are to be maintained in the relationship recited in these claims.

30. None of claims 3, 15, 19, 26, 27, 30, and 31 of amended Schedule A and claims 6, 8, 16, and 23 through 28 of Schedule B of the complaint distinguishes patentably over the Moxham patent.

31. None of claims 3, 15, 19, 26, 27, 30, and 31 of amended Schedule A and claims 6, 8, 16, and 23 through 28 of Schedule B of the complaint distinguishes patentably over the cited prior art.

32. Plaintiff has failed to prove clear error or lack of rational basis in the findings of fact in the decisions of the Board of Appeals in Appeals No. 343-33 and No. 343-34.

CONCLUSIONS OF LAW

1. The doctrine of *res judicata* is applicable to final decisions of Patent Office tribunals including the Board of Interference Examiners.

2. The decision of the Board of Appeals in Appeal No. 15,663 is not a final decision and, therefore, a holding of *res judicata* could not properly be based thereon.

3. In the absence of a perfected appeal after Peterson's notice of appeal to the Court of Customs and Patent Ap-

peals from the judgment of the Board of Interference Examiners awarding priority to Bodendieck in Interference No. 83,266, the unvacated judgment of that Board became a final judgment.

4. The Board of Appeals correctly held in Appeals No. 343-33 and 343-34 that the question of Peterson's right to make in his applications the respective claims listed in finding of fact No. 5 was *res judicata* on the basis of the decision of the Board of Interference Examiners at final hearing in Interference No. 83,266.

5. No patentable distinction is involved in mere matters of degree.

6. A claim is functional and unpatentable if it seeks to define the essential substance of an alleged invention in structure or apparatus merely by statements of intended purpose, result, desired characteristic or capability, or a mode of operation instead of by structure or by means for achieving the desired end.

7. Limitations not within the specific provisions of 35 U.S.C. 112 and involving merely introductory matter, statements of intended use, or "adapted" clauses, are patentably ineffective.

8. A patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

9. Plaintiff is not entitled to prevail in the absence of demonstration of clear error or lack of rational basis in the decisions of the Board of Appeals in Appeals No. 343-33 and No. 343-34.

10. Plaintiff is not entitled to a patent containing any of claims 3, 15, 19, 26, 27, 30, and 31 set forth in amended Schedule A of the complaint.

11. Plaintiff is not entitled to a patent on application Serial No. 698,312, containing any of claims 6, 7, 10, 11, and 22 of original Schedule A of the complaint, which claims were eliminated by granting of plaintiff's motion to dismiss and amend.

12. Plaintiff is not entitled to a patent containing any of claims 6, 8, 16, and 23 through 28 set forth in Schedule B of the complaint.

13. The complaint should be dismissed as to all the claims.

14. The Court has jurisdiction over the parties and over the subject matter in suit.

15. The Commissioner of Patents had original jurisdiction over the parties and over the applications and patent involved in Interference No. 83,266 at the time the party Bodendieck filed his disclaimer and concession of priority therein.

16. The authority of the Board of Appeals to review adverse decisions of Examiners upon applications for patents is contained in Title 35 U. S. Code, § 7, and an applicant's right to a review from adverse decisions of Examiners is contained in Title 35 U. C. Code, § 134.

17. An interference is a proceeding between two or more applications, or between one or more applications and a patent of different parties, all of which contain claims directed to the same invention.

18. The statutory disclaimer speaks from the date of the patent.

STATUTES AND RULES CITED

STATUTES

35 USC § 7:

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

35 USC § 134:

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal. (R. S. 4909; 35 U. S. C., 1946 ed., 57.)

35 USC § 112 (Last paragraph):

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (R. S. 4888; 35 U. S. C., 1946 ed., 33.)

35 USC § 135:

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any

pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

35 USC § 141:

Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects

to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case. (R. S. 4911; 35 U. S. C., 1946 ed., 59a.)

35 USC § 142:

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints. (R. S. 4912; 35 U. S. C., 1946 ed., 60.)

35 USC § 146:

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law. (R. S. 4915; 35 U. S. C., 1946 ed., 63. Act Mar. 3, 1927, ch. 364, 44 Stat. 1394 and Oct. 31, 1951, ch. 655, sec. 53a, 65 Stat. 728; 35 U. S. C., 1946 ed. 72a.)

Sec. 4917 R. S. (Then 35 USC § 65; now 35 USC § 253):

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment,

stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See R. S. secs. 973, 4922.]

PATENT OFFICE RULES

Rule 258:

In determining priority of invention, the Board of Patent Interferences will consider only priority of invention on the evidence submitted. Questions of patentability of a claim generally will not be considered in the decision on priority; and neither will the patentability of a claim to an opponent be considered, unless the non-patentability of the claim to the opponent will necessarily result in the conclusion that the party raising the question is in fact the prior inventor on the evidence before the Office, or relates to matters which have been determined to be ancillary to priority and must be considered, but a party shall not be entitled to raise such non-patentability unless he has duly presented and prosecuted a motion under rule 232 for the dissolution upon such ground or shows good reason why such a motion was not presented and prosecuted.

Rule 262(a) and (d):

Disclaimer, concession, abandonment. (a) An applicant or a patentee involved in an interference may, at any time, file a written disclaimer or concession of priority, or abandonment of the invention, signed by the inventor in person

with the written consent of the assignee when there has been an assignment. Upon the filing of such an instrument by any party, judgment shall be rendered against him.

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(d) Such disclaimer, concession of priority, abandonment of the invention, or abandonment of the contest shall operate without further action as a direction to cancel the claims involved from the application of the party making the same on termination of the interference on the basis thereof.

Rule 263:

Statutory disclaimer by patentee. The disclaimer referred to in rule 262, when made by a patentee in interference is not a disclaimer under 35 U. S. C. 253. If a disclaimer under the statute (see rule 321) cancelling claims involved in the interference from the patent, is made by the patentee, including all assignees as shown by the records of the Patent Office, the interference will be dissolved pro forma as to such claims.

COURT OF CUSTOMS & PATENT APPEALS

Rule XXV (1.):

PETITION OF APPEAL—TRANSCRIPT OF RECORD

1. In appeals from the Patent Office the appealing party shall file in the clerk's office a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of sections 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the Commissioner. Said reasons for appeal having been filed

with the Commissioner of Patents and made a part of the record, shall not be repeated in the petition of appeal. Said petition of appeal and a certified copy of the record in the proceeding shall be filed in this court and the case duly docketed within 40 days (exclusive of Sundays and legal holidays) from the date upon which said reasons for appeal were filed with the Commissioner of Patents: *Provided*, That the commissioner may for special and sufficient cause extend such time to some definite and fixed date: *Provided, further*, That in inter partes cases appellant shall, at the time of filing said petition of appeal in this court, or within 10 days thereafter, serve a copy thereof upon appellee or his counsel.

If said petition of appeal and copy of said record shall not be filed within said period of 40 days, unless such time be extended by the commissioner as heretofore provided, the commissioner, upon such facts being brought to his attention by motion of the appellee in inter partes cases, duly served upon the appellant or his attorney, and upon his own motion in ex parte appeals, may take such further proceedings in the case as may be necessary to dispose of the same as though no notice of appeal had ever been given. *Provided, however*, That if any adverse party in an interference case shall, within 20 days after appellant shall have filed notice of appeal to this court, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes, certified copies of the notice of appeal and the notice of election shall be transmitted to this court by the Commissioner of Patents for appropriate action according to law.

CHRONOLOGY

First Application filed	September 20, 1946
Second Application filed	January 14, 1948
Interference No. 83,266 (v. Bodendieck) declared	March 31, 1948
Judgment of Interference Board entered	May 23, 1950
Rehearing denied	July 31, 1950
Interference No. 83,266 appealed to the CCPA	August 25, 1950
Bodendieck Disclaimer filed	December 7, 1950
Motion to Vacate Interference Judgment denied	December 21, 1950
Limit to perfect appeal to CCPA	December 22, 1950
Decision of Board of Appeals, ex parte, both cases	April 30, 1954
Rehearing denied	June 28, 1954
Civil Action 3229-54 decided	March 13, 1957
Appeal No. 13,938 to this Court (103 US App. DC 286; 257 F. 2d 664) decided	June 26, 1958
Rehearing denied	September 4, 1958
Certiorari denied (79 SC 352; 358 US 945; 3 L. E. 2d 351)	January 26, 1959
Motion for new trial denied	April 15, 1959
Appeal No. 15,270 (280 F.2d 643) decided	June 9, 1960
This petition filed	October 7, 1960